

REMARKS

Applicant hereby traverses the outstanding objections and rejections, and requests reconsideration and withdrawal in light of the amendments and remarks contained herein. Claims 1-20 are pending in this application.

Abstract

The Abstract is objected to for the informality listed on page 2 of the Office Action. In response, Applicant has amended the Abstract in accordance with the suggestion provided on page 2 of the Office Action. As the amendment addresses the recited informality, Applicant respectfully requests the withdrawal of the objection of record.

Objection to the Claims

Claim 20 is objected to for the informality listed on page 2 of the Office Action. In response, Applicant has amended claim 20 in accordance with the suggestion provided on page 2 of the Office Action. As the amendment addresses the recited informality, Applicant respectfully requests the withdrawal of the objection of record.

Rejection under 35 U.S.C. § 103

Claims 1 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ho et al. ('235, hereinafter Ho) in view of El-Batal et al. ('144, hereinafter El-Batal).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criteria, Applicant asserts that the rejection does not satisfy the first and third criteria.

Lack of Motivation

The Office Action admits that Ho does not teach having a low bandwidth interface. The Office Action attempts to cure this deficiency by introducing El-Batal, which the Office

Action alleges to teach having such an element. The motivation for making the combination was presented as follows:

“The motivation to combine is because low bandwidth interfaces are often used for connecting slower hardware devices to local area networks, such as Ethernet or Fiber Channel.”

It is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. § 2143.01. The language of the motivation is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. Moreover, the language of the recited motivation is circular in nature, stating that it is obvious to make the modification because it is obvious to achieve the result. Again, such language is a statement that the references can be modified and does not provide any desirability for making the modification. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

No valid suggestion has been made as to why a combination of Ho and El-Batal is desirable. Therefore, the rejection of claims 1 and 17 should be withdrawn.

Lack of Limitations

The Office Action admits that Ho does not teach having a low bandwidth interface. The Office Action attempts to cure this deficiency by introducing El-Batal, which the Office Action alleges to teach having such an element. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Claim 1 defines a method for facilitating communication over a fibre channel (FC) system via a low bandwidth interface connected to a user device and includes receiving first information from the FC system, wherein the first information is associated with a storage

device disposed in the FC system... and communicating the first stored information via the low bandwidth interface to the user device. The combination of Ho and El-Batal does not disclose at least these limitations. More specifically, the combination of Ho and El-Batal does not disclose communicating information received from the FC system via the low bandwidth interface. The Office Action states that Ho does not teach a low bandwidth interface. El-Batal appears to teach a RS-232 interface, but does not teach that information from an FC system is communicated via the RS-232 interface. Thus, the combination of Ho and El-Batal does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 1 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 17 defines a system for facilitating communication between fibre channel arbitrated loop topologies via a low bandwidth interface connected to a user device, that includes a microprocessor that causes information received from at least one of the first and second fibre channel arbitrated loop topologies to be buffered before communication via the low bandwidth interface. The combination of Ho and El-Batal does not disclose at least these limitations. More specifically, the combination of Ho and El-Batal does not disclose having a microprocessor that causes information received from at least one of the first and second fibre channel arbitrated loop topologies to be buffered before communication via the low bandwidth interface. The Office Action states that Ho does not teach a low bandwidth interface. El-Batal appears to teach a RS-232 interface, but does not teach that information from an FC loop topology is communicated via the RS-232 interface. Thus, the combination of Ho and El-Batal does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 17 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Rejection under 35 U.S.C. § 103

Claims 2-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ho in view of El-Batal, further in view of Miller et al. ('360, hereinafter Miller).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criteria, Applicant asserts that the rejection does not satisfy the first and third criteria.

Lack of Motivation

Claims 2-6 depend from claim 1. The motivation used in the combination of Ho and El-Batal is insufficient for the reasons cited above. The motivation used to combine Miller with the combination of Ho and El-Batal does not overcome the insufficiency of the motivation used to combine Ho and El-Batal. Therefore there is no valid suggestion as to why a combination of Ho, El-Batal, and Miller is desirable. Therefore, the rejection of claims 2-6 should be withdrawn.

Lack of Limitations

Claim 1 is defined as described above. The combination of Ho and El-Batal does not disclose these limitations, as discussed above. Miller is not relied upon in the Office Action as disclosing these limitations. Therefore, the combination of references does not teach all elements of the claimed invention of claim 1.

Claims 2-6 depend from base claim 1, and thus inherit all limitations of claim 1. Each of claims 2-6 sets forth features and limitations not recited by the combination of references. Thus, the Applicant respectfully asserts that for the above reasons claims 2-6 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Rejection under 35 U.S.C. § 103

Claims 9-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ho in view of El-Batal, further in view of Miller.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to

combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criteria, Applicant asserts that the rejection does not satisfy the first and third criteria.

Lack of Motivation

The Office Action admits that Ho does not teach having a low bandwidth interface. The Office Action attempts to cure this deficiency by introducing El-Batal, which the Office Action alleges to teach having such an element. The Office Action also admits the Ho does not teach arbitrated access to the FC when the amount of second stored information exceeds a predetermined value. The Office Action attempts to cure this deficiency by introducing Miller, which the Office Action alleges to teach having such an element.

The motivation for making the combination was presented as follows:

“The motivation to combine is: (1) to achieve better data transfer rate matching between low speed interfaces and high-speed networks, and (2) low bandwidth interfaces are often used for connecting slower hardware devices to local area networks, such as Ethernet or Fiber Channel.”

It is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. § 2143.01. Both statements are merely statements that the references can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. Moreover, the language of the recited motivation statements is circular in nature, stating that it is obvious to make the modification because it is obvious to achieve the result. Again, such language is a statement that the references can be modified and does not provide any desirability for making the modification. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

Furthermore, it appears that the second statement is the motivation for combining Ho and El-Batal, as the same motivation is used in the rejection of claims 1 and 17. Consequently, it appears that first statement is used to combine Miller with the combination of Ho and El-Batal. The cited motivation of the first statement does not provide any desirability modifying Ho to include the missing element as identified by the rejection, namely arbitrated access to the FC when the amount of second stored information exceeds a predetermined value.

No valid suggestion has been made as to why a combination of Ho and El-Batal is desirable. Therefore, the rejection of claims 9-16 should be withdrawn.

Lack of Limitations

The Office Action admits that Ho does not teach having a low bandwidth interface. The Office Action attempts to cure this deficiency by introducing El-Batal, which the Office Action alleges to teach having such an element. The Office Action also admits the Ho does not teach arbitrated access to the FC when the amount of second stored information exceeds a predetermined value. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Claim 9 defines a system for facilitating communication over a fibre channel (FC) system via a low bandwidth interface connected to a user device that includes a microprocessor that causes information received from the FC system to be buffered before communication via the low bandwidth interface. The combination of Ho, El-Batal, and Miller does not appear to disclose at least these limitations. The Office Action states that Ho does not teach a low bandwidth interface. The Office Action does not rely upon Miller as teaching a low bandwidth interface. El-Batal appears to teach a RS-232 interface, but does not teach that information from an FC system is communicated via the RS-232 interface. Thus, the combination of Ho, El-Batal, and Miller does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 9 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claims 10-16 depend from base claim 9, and thus inherit all limitations of claim 9. Each of claims 10-16 sets forth features and limitations not recited by the combination of references. Thus, the Applicant respectfully asserts that for the above reasons claims 10-16 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Rejection under 35 U.S.C. § 103

Claims 7-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ho in view of El-Batal, further in view of Miller, still further in view of Bhagwat et al. ('805, hereinafter Bhagwat).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criteria, Applicant asserts that the rejection does not satisfy the first and third criteria.

Lack of Motivation

Claims 7-8 depend from claim 6. The motivation used in the combination of Ho, El-Batal, and Miller is insufficient for the reasons cited above. The motivation used to combine Bhagwat with the combination of Ho, El-Batal, and Miller does not overcome the insufficiency of the motivation used to combine Ho, El-Batal, and Miller. Therefore there is no valid suggestion as to why a combination of Ho, El-Batal, Miller, and Bhagwat is desirable. Therefore, the rejection of claims 7-8 should be withdrawn.

Lack of Limitations

Claim 6 is defined as described above. The combination of Ho, El-Batal, and Miller does not disclose these limitations, as discussed above. Bhagwat is not relied upon in the Office Action as disclosing these limitations. Therefore, the combination of references does not teach all elements of the claimed invention of claim 6.

Claims 7-8 depend from claim 6, which in turn depends from claim 1, and thus inherit all limitations of claims 1 and 6. Each of claims 7-8 sets forth features and limitations not recited by the combination of references. Thus, the Applicant respectfully asserts that for the above reasons claims 7-8 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Rejection under 35 U.S.C. § 103

Claims 18-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ho in view of El-Batal, further in view of Vajk et al. ('033, hereinafter Vajk).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criteria, Applicant asserts that the rejection does not satisfy the first and third criteria.

Lack of Motivation

Claims 18-20 depend from claim 17. The motivation used in the combination of Ho and El-Batal is insufficient for the reasons cited above. The motivation used to combine Vajk with the combination of Ho and El-Batal does not overcome the insufficiency of the motivation used to combine Ho and El-Batal. Therefore there is no valid suggestion as to why a combination of Ho, El-Batal, and Vajk is desirable. Therefore, the rejection of claims 18-20 should be withdrawn.

Lack of Limitations

Claim 17 is defined as described above. The combination of Ho and El-Batal does not disclose these limitations, as discussed above. Vajk is not relied upon in the Office Action as disclosing these limitations. Therefore, the combination of references does not teach all elements of the claimed invention of claim 17.

Claims 18-20 depend from base claim 17, and thus inherit all limitations of claim 17. Each of claims 18-20 sets forth features and limitations not recited by the combination of references. Thus, the Applicant respectfully asserts that for the above reasons claims 18-20 are patentable over the 35 U.S.C. § 103(a) rejection of record.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10002385-1, from which the undersigned is authorized to draw.

Dated: November 2, 2004

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482734103US, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: November 2, 2004

Signature:

Joy H. Perigo

Respectfully submitted,

By

Michael A. Papalas

Registration No.: 40,381

Attorney for Applicant

(214) 855-8186